No. 86-891

IN THE

Supreme Court of the United States

OCTOBER TERM, 1986

MEAD DATA CENTRAL, INC.,

Petitioner,

—against—

WEST PUBLISHING COMPANY,

Respondent.

PETITIONER'S REPLY BRIEF

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West's Brief in Opposition understandably fails to defend —or even to mention—the actual holdings of the courts below. West has nothing to say in defense of the District Court's holding that "page numbers themselves are protected by copyright," 616 F. Supp. at 1579 [Appendix C at C11], or the Court of Appeals majority's altogether different holdings that "jump cites" are infringing because they impart "knowledge" of where specific portions of judicial opinions can be found, or because readers might use them to deduce the sequence of opinions in published volumes. 799 F.2d at 1227-28 [Appendix A at A15].

Because the holdings below are so obviously wrong and constitute "a most extreme misreading" of the law of copyright, W. Patry, Latman's The Copyright Law 63 n.212

(6th ed. 1986),[1] West does not even argue their correctness here. Instead, by means of misstatement and incorrect paraphrasing, West attempts to make this case appear to involve ordinary and different issues than were actually presented and decided below.

West's attempted recasting of this case can be appreciated by comparing West's Brief in Opposition with the corresponding portions of the record:

West's Brief in Opposition	*Record*
"The Complaint sought relief from MDC's announced plan to reproduce . . . West's *arrangements*. . . ." (West Br. at 2) (emphasis added).	"The *page numbers* contained in each volume of West's National Reporter System publications are a material and substantial portion thereof. . . . . . . MDC's intended use of West's *page numbers* will constitute copyright infringement . . . ." (Complaint ¶¶ 27, 28) (emphasis added).
* * *	* * *

[1] Referring to the District Court's decision in this case, Mr. Patry continues:

> Contrary to this decision, there is no copyrightable interest in the pagination of plaintiff's reporters. The numbering of the pages is a purely mechanical process dictated entirely by the format. There is no "collection and assembling of pre-existing materials or data," and there is no selection, coordination, or arrangement of any such material.

W. Patry, Latman's The Copyright Law 63 n.212 (6th ed. 1986).

West's Brief in Opposition	*Record*
"West moved for a preliminary injunction restraining MDC from further reproduction and display of West's *arrangements* . . . ." (West Br. at 2-3).	"PLEASE TAKE NOTICE that . . . [West] will move the Court for a preliminary injunction enjoining [MDC] . . . from displaying, referencing or including the *page numbers* of plaintiff's National Reporter System publications . . . within or in relation to the text of court opinions in . . . LEXIS" (Notice of Motion dated August 27, 1985) (emphasis added).
* * *	* * *
"[T]he district court's order only prevents MDC from reproducing and displaying West's particular *arrangements*. . . ." (West Br. at 11) (emphasis added).	"IT IS HEREBY ORDERED that defendant . . . [is] preliminarily enjoined from displaying, referencing or including the *page numbers* of [West publications] . . . within or in relation to the text of court opinions. . . ." (Appendix D at D2) (emphasis added).
* * *	* * *

West's Brief in Opposition	*Record*
"[T]he issue is whether MDC is reproducing West's . . . *arrangements* of case reports" (West Br. at 9) (emphasis added).	"[T]his case turns on whether or not the succeeding *page numbers* themselves are protected by copyright." 616 F. Supp. at 1579 [Appendix C at C11]; 799 F.2d at 1236 [Appendix B at B15] (Oliver, J., dissenting) (emphasis added).
* * *	* * *
"MDC's contention that West's 'page numbers' are uncopyrightable misapprehends the *expression* the Court of Appeals held was *protected* by copyright law" (West Br. at 9) (emphasis added).	"[T]he specific goal of this suit is to *protect* some of West's *page numbers,* those occurring within the body of individual court opinions." 799 F.2d at 1227 [Appendix A at A13] (emphasis added).

West's protestations to this Court notwithstanding, the purported "arrangements" of opinions in West publications have nothing to do with this case. While original "arranging" activity may, in appropriate circumstances, be protected by copyright,

> this was *not* the activity [West] sought to protect. Rather, [West] claimed an interest in the mechanical process of assigning page numbers to the compilation *after* it was created. W. Patry, Latman's The Copyright Law 63 n.212 (6th ed. 1986) (emphasis in original).

Reflecting this fact, the preliminary injunction in this case does not even mention any purported "arrangements" in West publications (see Appendix D).

The very nature of star pagination, furthermore, demonstrates that it involves no "reproduction" or "display" of how cited sources may be "arranged." Both *Lawyers' Edition* ("L. Ed.") and *Supreme Court Reporter* ("Sup. Ct.") volumes star paginate to *U.S. Reports* ("U.S."), yet the "arrangement" of opinions in L. Ed. and Sup. Ct. volumes, as the Court is doubtless aware, bears no similarity whatever to that in U.S. volumes. Similarly, the LEXIS Star Pagination Feature would not change at all the way in which opinions are now reported and "arranged" in LEXIS, which "arrangement" bears no similarity whatever to that in any West publication. The only change would be the addition of jump cite references to the page numbers of published sources, as shown in Appendix F to MDC's petition.

When the issue that was actually presented and ruled on below—"MDC's proposed use of West page numbers," 799 F.2d at 1227 [Appendix A at A14]—is kept in mind, the basis for West's opposition to certiorari evaporates. There is no dispute about the nature or uses of star pagination, the decisions below clearly conflict with applicable decisions of this Court and of the Second Circuit, and the importance of star pagination to the legal profession is beyond doubt.

I.

The Court of Appeals' Decision Is Ripe for Review on the Present Record.

With the LEXIS Star Pagination Feature, "MDC intends to do no more than what other law book publishers have been doing for a long, long period of time." 799 F.2d at 1235 [Appendix B at B13] (Oliver, J., dissenting). The

nature of star pagination—how it works and what it does—is familiar to every lawyer, and has been in common use in this country for more than 100 years. Neither the District Court nor the Court of Appeals had the slightest difficulty understanding "MDC's proposed use of West page numbers." 799 F.2d at 1227 [Appendix A at A14]. West's suggestion that there are undeveloped "facts" which "may" bear on how star pagination "uses" page numbers (West Br. at 12) is, at best, baseless speculation.

Review now by this Court is essential, not only because of the importance of this case to the legal profession, but because the holdings below are "fundamental to the further conduct of the case." *United States* v. *General Motors Corp.*, 323 U.S. 373, 377 (1944). Absent this Court's timely intervention, the parties will be required to spend what may be years litigating, at enormous cost to themselves and the judicial system, issues such as West's purported "arranging" activity over a 75-year period which have no relevance to this case under a proper view of the law. The legal issues presented in MDC's petition are dispositive of the copyright claims in this case, and can and should be decided now.

II.

The Court of Appeals' Decision Conflicts With Applicable Decisions of This Court.

As MDC has previously shown, the Court of Appeals majority wrongly extended copyright protection to bar use of uncopyrighted matter, and did so even though the Copyright Act of 1976 confers upon authors no exclusive right to make "jump cites," to make "references," to impart "knowledge of the location" of published matter, or any remotely analogous rights. *See* 17 U.S.C. § 106 [Appendix E at E4].

The lower courts' injunction against "MDC's proposed use of West page numbers," 799 F.2d at 1227 [Appendix A at A14], plainly conflicts with applicable decisions of this Court. West now concedes that "page numbers, cannot be copyrighted" (West Br. at 9). Under this Court's decision in *Harper & Row, Publishers, Inc.* v. *Nation Enterprises,* 105 S. Ct. 2218 (1985), it is settled that "copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original." *Id.* at 2224. West's Brief in Opposition does not dispute, but simply disregards this principle and its applicability to uncopyrighted page numbers.

West's assertion that "star pagination supplants the need for West's reporters" (West Br. at 5 n.6) similarly ignores that copyright protection does not extend to "constituent elements" of a work "that are not original," *Harper & Row, Publishers, Inc.* v. *Nation Enterprises,* 105 S. Ct. 2218, 2224 (1985), and does not prohibit uses which are not exclusively reserved to authors under 17 U.S.C. § 106 (1982) [Appendix E at E4]. If star pagination or any other "unlicensed use of a copyrighted work does not conflict with an 'exclusive' right conferred by the [copyright] statute, it is no infringement of the holder's rights." *Twentieth Century Music Corp.* v. *Aiken,* 422 U.S. 151, 155 (1975). *Accord Sony Corp.* v. *Universal City Studios, Inc.,* 464 U.S. 417, 433 (1984).

III.

The Court of Appeals' Decision Conflicts With a Decision of the Second Circuit on the Identical Question.

The conflict between *Banks Law Publishing Co.* v. *Lawyers' Co-Operative Publishing Co.,* 169 F. 369 (2d Cir. 1909), *appeal dismissed,* 223 U.S. 738 (1911), in which

star pagination was held *not* to be an infringement of copyright, and the majority opinion below, which held that star pagination *would be* an infringement of copyright, could hardly be more obvious. The Second Circuit in *Banks* held that the page numbers of the plaintiff's volumes were not an "original" element thereof, and the majority below reached the same conclusion. But unlike the majority below, the Second Circuit in *Banks* correctly held that star page references to uncopyrighted page numbers could not be an infringement of copyright, even though the defendant's reporting of opinions with star paging undoubtedly "supplanted" sales of the plaintiff's reports.[2]

West wrongly asserts (West Br. at 7) that the outcome in *Banks* was somehow affected by the plaintiff's "official" status, and by a supposed absence in 1909 of copyright protection for compilations. Both assertions are specious.

It was undisputed in *Banks* that the plaintiff's volumes—in which federal statutory copyright had been registered and perfected—were protected by copyright; the only issue was whether, as in this case, the plaintiff's copyright claims extended to page numbers. The outcome in *Banks* was determined, not by any lack of statutory protection for compilations, but by the lack of any creative intellectual labor behind "such details" as page numbers. 169 F. at 391.

The Second Circuit in *Banks* also considered, and expressly *rejected*, the theory (put forward by West here) that the plaintiff's "official" status in that case operated to preclude a finding of infringement. Contrary to West's mischaracterization, the Second Circuit in *Banks* held that

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[2] "[O]n the facts in *Banks*, the purchase of defendant's 'L.Ed.' because of defendant's use of star pagination, completely eliminated the need to purchase any of plaintiff's 'U.S.' reports." 799 F.2d at 1245 [Appendix B at B36] (Oliver, J., dissenting).

official reporters, no less than unofficial reporters, are entitled to copyright protection for their original writings, *see* 169 F. at 388; *accord Callaghan* v. *Myers,* 128 U.S. 617, 647 (1888), but that sequential page numbers are not "original" in the copyright sense. Judicial notice can be taken that "official" reports of opinions—such as N.Y.2d, Cal. 3d, and U.S. App. D.C.—bear copyright notices and are registered with the Copyright Office, notwithstanding their publishers' "official" status.

IV.

The Issues Presented in MDC's Petition Are of General and Public Importance.

West asserts that the outcome of this case "has virtually no impact on non-parties or the public at large" (West Br. at 13). The assertion is patently untrue. The preliminary injunction in this case affects the way in which the entire legal profession can conduct legal research, and has deprived a substantial segment of the public—including all those who cannot afford or who have no room for thousands and thousands of books—of the ability to comprehend or to make jump citations to published judicial opinions, or to comply with court rules and conventions which require jump citations to opinions as reported in West publications.

The importance of star pagination to the legal profession is beyond doubt. It is demonstrated by its appearance in thousands upon thousands of West and non-West reports of opinions spanning more than 100 years. To ban star pagination is to deprive the profession and the public of an important means of access to judicial opinions and, in this case, of an important technological achievement. The lower courts have acted to restrain effective competition between MDC and West, to block off public access to public domain material, and to force the legal profession

—as a condition of being able to cite case law authorities in accordance with court rules and universal custom—to deal with a copyright monopolist and pay whatever tribute West may choose to exact for the privilege.

This case, in short, clearly raises issues of general and public importance which merit immediate review by this Court.

CONCLUSION

For the reasons set forth above and in MDC's original petition, a writ of certiorari should issue to review the judgment of the Court of Appeals for the Eighth Circuit.

Respectfully submitted,

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